

## REMARKS

Claims 1-17 are pending in the application.

Claims 1-17 stand rejected under 35 U.S.C. § 112, ¶ 1 for failing to comply with the written description requirement.

Claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Muhlebach.

Claims 1-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Muhlebach in view of Hazen.

Applicants respectfully request reconsideration of the pending claims in light of the following remarks.

### **REJECTIONS UNDER 35 U.S.C. § 112 ¶ 1**

In the Office Action, the Examiner maintains the previous rejection of the claims under 35 U.S.C. § 112 for failing to comply with the written description requirement.

Applicants continue to disagree with the Examiner's § 112 rejection. Applicants have substantially amended claim 1 for the Examiner's consideration. Applicants' submit that the present specification contains a written description of the invention, and of the manner and process of making it, in such in full, clear, and exact terms as to enable one ordinary skilled in the art to make and use the same.

The herbicidal composition currently claimed in amended claim 1 is comprised of a compound of formula I and at least one co-herbicide selected from 29 specific co-herbicides.

The Examiner may appreciate that amended claim 1 is significantly narrower in scope than as originally filed. Indeed, the compound of formula (I) as now recited has the general structure represented as (Ie) in Applicants' specification. Applicants' specification provides numerous examples of compounds having the general structure of formula (Ie). These examples can be found in Applicants' specification, for example, in Table 1 located on pages 25-30.<sup>1</sup>

The 29 co-herbicides remaining in amended claim 1, and the increased herbicidal action exhibited by these co-herbicides in combination with the selected compound of formula (I) is clearly described in Applicants' specification in such a way as to reasonably convey to one skilled in the art that the inventors has possession of the claimed invention at the time of filing. Applicants have at a minimum illustrated a representative sample of the selective herbicidal action of the compound of formula I and each of the 29 herbicides.

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<sup>1</sup> The page numbers referenced correlate to the pagination of WO 01/17351

Reference is made to pages 39-45 of the present specification, as well as the five Declarations of Jutta Glock submitted in response to the Office Action dated February 23, 2005. Particularly, the specification and the Declarations demonstrate the herbicidal action of over 30 different compositions comprised of a selected compound of formula (I) and a selected co-herbicide. Specifically, the Examiner's attention is directed to all five of the Glock Declarations and pages 40-44 of the present specification wherein the synergism is demonstrated between a selected compound of formula (Ie) and the following members of the 29 co-herbicides listed below:

- *Clodinafop-P-propargyl*
- *Fenoxyprop-P-ethyl*
- *Tralkoxydim*
- *Triasulfuron*
- *Amidosulfuron*
- *Tribenuron*
- *Idosulfuron*
- *Thifensulfuron-methyl*
- *Metsulfuron*
- *Flupyrifluron*
- *Sulfosulfuron*
- *Mecoprop*
- *Fluroxypyr*
- *MCPA*
- *2,4-D ester*
- *2,4-D amine*
- *Triallate*
- *Prosulfocarb*
- *Dicamba*
- *Diflufenican*
- *Bromoxynil*
- *loxynil*
- *Florasulam*
- *Flucarbazone*
- *Propoxycarbazone*
- *Metosulam*

Applicants respectfully submit that they have provided more than a sufficient number of representative examples such that one of skill in the art would expect that any select compound of formula (I) and second herbicide as claimed would be expected to perform in the same manner without undue experimentation. To argue the contrary will require more than a general allegation that Applicants' disclosure would have not taught one skilled in the art how to make and use the full scope of the claimed invention. Indeed, as provided in MPEP § 2164.03. "[p]roof of enablement will be required for other members of the claimed genus *only where adequate reasons* are advanced by the examiner to establish that a person skilled in the art could not use the genus as a *whole* without undue experimentation." (MPEP § 2164.03, p. 2100-196).

Applicants note that, as currently claimed, the variants for formula I are limited and include only three (3) functional groups defining the G substituent, i.e., hydrogen, carboxylic acids and carboxylic esters, while the definitions for R<sup>1</sup> and R<sup>2</sup> are limited to only alkyl, alkyloxy, alkynyl, halogenated alkyl and halogenated alkyloxy. Given the teachings of the specification and the

compounds exemplified in the table at pages 25-30, Applicants respectfully submit that the specification exemplifies a representative sample of these compounds such that one of ordinary skill in the art would be able to make and use all compounds embraced by the claims without undue experimentation. Absent concrete examples of compounds falling within the claims that are not enabled, Applicants respectfully submit that the Examiner has failed to establish lack of enablement. Respectfully, Applicants request withdrawal of the rejection under 35 USC § 112.

#### **REJECTIONS UNDER 35 U.S.C. § 103**

Claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Muhlebach.

Claims 1-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Muhlebach in view of Hazen.

As previously discussed, Applicants note that the primary reference of Muhlebach does not qualify as prior art. Further, the Examiner has previously stated that arguments related to the Muhlebach reference presented in the Response filed on January 4, 2005, were persuasive and the Examiner then withdrew the rejection. See specifically page 2 of the Office Action mailed on August 11, 2005.

Furthermore, with reference to the Muhlebach et al. citation, Muhlebach et. al (WO 99/47525, US 6,410,480) is **NOT** prior art under 103(a)/102(e), (f), or (g). The WO 99/47525 application was filed March 3, 1999; and is not available as prior art under the revisions of the American Inventors Protection Act of 1999. International filing dates prior to November 29, 2000 cannot be used under 102(e) for prior art purposes. In fact, publications of international applications filed before November 29, 2000 do not have a 102(e) date at all.

Under pre-AIPA law which applies in this case, WO 99/47525 has a publication date of September 23, 1999, which is after the filing date of the present application. The present application has an effective filing date of September 7, 1999 (i.e. before the publication of the cited reference). Response, page 2.

Applicants respectfully reiterate the argument presented above that the primary reference, WO99/47525 (and it U.S. equivalent, US 6410480) does not qualify as prior art in this case. As the primary reference cannot be asserted against the present claims, the rejection of claims 1-7 cannot be maintained.

Similarly, with respect to the rejection of claims 1-17 as being unpatentable over Muhlebach in view of Hazen, Applicants respectfully request withdrawal of the rejection. As the Muhlebach reference does not qualify as prior art, the Examiner has not shown that Hazen alone teaches or suggests the present invention at the time the invention was made. Specifically, Hazen fails to

teach the specific compounds of formula I, and it fails to teach such compounds in combination with co-herbicides. Accordingly, Applicants request withdrawal of the rejection.

Based upon the foregoing then, Applicants submit that the pending claims are in condition for allowance and the Examiner is courteously solicited to pass this application on to allowance. No other fees are believed to be payable at this time. However, the Commissioner is authorized to debit any applicable fees from the deposit account of the undersigned, no 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,

USPTO Customer No. 26748  
Syngenta Crop Protection, Inc.  
Patent and Trademark Dept.  
410 Swing Road  
Greensboro, NC 27409  
(336) 632-6757

JAMES CUEVA/  
James Cueva  
Attorney for Applicants  
Reg. No. 58,558

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